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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,826	03/09/2004	Yuichiro Itakura	JCLA21100	2452
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J C PATENTS, INC. 4 VENTURE, SUITE 250 IRVINE, CA 92618			EXAMINER DUNHAM, JASON B	
			ART UNIT	PAPER NUMBER
			3625	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/796,826

**Applicant(s)**

ITAKURA ET AL.

**Examiner**

JASON B. DUNHAM

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant amended claims 1-3 and 5-18 in the response filed October 21, 2008 in reply to the office action dated July 22, 2008. Claims 1-18 are pending.

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on application H8-163679 filed in Japan on June 5, 1996. It is noted, however, that applicant has not filed a certified copy in this United States application of the Japanese application as required by 35 U.S.C. 119(b).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 and 10-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The above claims recite the amended limitation, "party of said private network being outside of said payment system". Applicant noted figure 1 and paragraphs 66, 93-94, and 97 in the remarks

dated October 21, 2008 as providing support for this amendment; however the Examiner cannot find any support in the above sections or any part of the applicant's disclosure conveying the meaning of the above limitation. For purposes of examination, the Internet and the private network will be considered separately as disclosed by applicant's figure 1.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by  
Rose (US 5,757,917).**

Referring to claim 1. Rose discloses a terminal having a browser for communicating a host server using the Internet, said terminal communicating with a payment system through a private network comprising:

- A message viewer for communicating with said private network without using the Internet, part of said private network being outside said payment system (Rose: abstract & column 3, lines 51-67 and column 11, line 64 – column 12, line 29.

The examiner notes that columns 8 and 12 of Rose discloses a message system

that is part of the private network and on a "below the line" or private network);  
and

- A communication means by which said browser communicates with said (Internet?) and said message viewer communicates with said private network using different logical links (Rose abstract, figure 2, and column 3, line 51 – column 4, line 15), wherein;
- Said browser includes means for ordering goods from said host server connected to the Internet, means for receiving a bill for said goods from the Internet, and means for transmitting said bill to said message viewer (Rose: figures 5 and 6a-6f), and wherein
- Said message viewer includes means for paying said bill by communicating with said payment system through said private network without using the Internet (Rose: abstract and figure 8 disclosing payment through a private network).

Referring to claim 2. Rose further discloses an apparatus, wherein said message viewer includes:

- Means for receiving information indicative of payment completion from said private network (Rose: abstract); and
- Means for transmitting said information indicative of payment completion to said browser (Rose: figure 5), and
- Said browser includes means for notifying said host computer of said payment completion through the Internet (Rose: figure 5).

Referring to claim 3. Rose further discloses an apparatus as discussed above in the rejection to claim 1 and further discloses an apparatus wherein:

- Said message viewer includes means for ordering goods through said private network, means for receiving a bill for said goods from said private network, payment means for paying said bill by communicating with said payment system through said private network, without using the Internet, and means for transmitting information that said order and said payment have been completed to said browser (Rose: column 9, line 65 – column 10, line 13); and wherein
- Said browser (notifies?) the Internet of said completion of said order and said payment (Rose: figure 6f).

Referring to claim 4. Rose further discloses an apparatus wherein payment means of said message viewer transmits a credit card number and an expiration date of a user of said terminal to said private network (Rose: figure 1).

Referring to claim 5. Rose further discloses an information provider having a gateway through which a terminal accesses a host computer using the Internet, and a connection manager which manages a communication through said gateway, said information provider comprising:

- A message manager which communicates with said terminal independently from said gateway, wherein:
  - Said gateway includes means for transmitting said goods order input from said terminal to said host computer connected to said web; and means for transmitting a price information of said goods from said host computer

through the Internet to said terminal (Rose: column 7, lines 48 –67). The examiner notes that a gateway is a device for connecting networks using different communications protocols so that information can be passed from one to the other. Rose discloses using an interactive protocol to contact the seller's address to transmit price information.

- Said message manager enables payments through said private line, and said message manager includes means for receiving said price information from said terminal, and request means for requesting said payment system to pay an amount indicated by said price information through said private line without using the Internet (Rose: column 9, line 65 – column 10, line 13).

Referring to claims 6-9. Claims 6-9 are rejected under the same rationale set forth above.

Referring to claim 10. Rose further discloses a system for paying for goods ordered through the Internet by a user of a terminal accessing a host computer using the Internet, said system communicating with the terminal through a private line comprising:

- A user database for storing a credit card number and an expiration date of a credit card owned by said user (Rose: figure 1);
- An interface for connecting to a closed network which executes a payment by a credit card (Rose: figure 1);

- Means for communicating with said terminal using a private network without using the Internet, which is logically independent from a communication established between the Internet and said terminal, part of said private network being outside said system (Rose: column 3, line 51 – column 4, line 15 and column 11, line 64 – column 12, line 29); The examiner notes that columns 8 and 12 of Rose discloses a message system that is part of the private network and on a "below the line" or private network
- Means for receiving information indicative of a paying request an amount of payment and a store dealing in said goods from said terminal through said private network, without using the Internet (Rose: column 3, lines 39 – 50);
- Means for reading said credit card number and said expiration date from said user database (Rose: figure 1);
- Means for transmitting said information indicative of said amount of payment and said store dealing in said goods, together with said credit card number and said expiration date to said private network, without using the Internet (Rose: figure 5); and
- Means for receiving information indicative of whether said credit card has been verified (Rose: column 6, lines 15 – 37).

Referring to claim 11. Claim 11 is rejected under the same rationale set forth in the rejection to claim 10.

Referring to claim 12. Rose further discloses a system comprising:

- A store database for storing a name of a store, which deals in goods, in association with said connection address of said host computer of said store (Rose: figure 9 and claim 13);
- Means for reading out said connection address of said host computer, which is identified by said store name, from said database (Rose: column 7, lines 48-67);
- Means for connecting to said host computer using said connection address through said private line (Rose: column 4, lines 1-15); and
- Means for notifying said host computer of said information indicative of whether said credit card has been verified through said private line (Rose: column 6, lines 15 – 37).

Referring to claims 13-18. Medium and apparatus claims 13-18 are rejected under the same rationale set forth above in the rejection of claims 1-5 containing similar limitations.

***Response to Arguments***

Applicant's arguments filed October 21, 2008 have been fully considered but they are not persuasive.

The examiner disagrees with applicant's contention that Rose does not disclose communication between the buyer terminal and payment system through a private network without using the Internet. The examiner disagrees and notes figures 1 and 8 and column 6, lines 15-37 disclosing a user communicating through a "below the line system" (i.e. private) with financial institutions 115 and 117 regarding payment. This communication does not take place between the "above" and "below" (public and private) portions of the system and as such meets the required claim language of "through said private network". Applicant further argues that the seller's agent 115 cannot be the terminal in claim 1. The examiner agrees on this point, however, disagrees that figure 8 of Rose does not disclose a terminal comprising a message viewer with means for paying a bill. Reference is made to column 10, line 50 - column 11, line 7 disclosing communication with the user's system (i.e. terminal) communicating with financial institutions 115 and 117 to authorize payment (for a bill) via messages. The rejection of independent claims 1, 3, 5, 7, 10, 11, 13, and 15 as well their respective dependent claims is maintained under this rationale.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON B. DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Smith/  
Supervisory Patent Examiner, Art  
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JBD  
1/8/09